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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN GAGE

Appeal 2010-003659
Application 10/072,531
Technology Center 2400

Before MAHSHID S. SAADAT, KRISTEN L. DROESCH and GREGORY J. GONSALVES, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks review under 35 U.S.C. § 134(a) of a final rejection of claims 1, 6, 7, 11, 14-18 and 25-38[1]. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM-IN-PART.

BACKGROUND

Appellant's invention relates to methods and apparatus for retrieving and storing the audio portion of multimedia programs. Spec. 1; Abs.

Independent claim 1 is illustrative and is reproduced below (disputed limitations in *italics*):

> An apparatus for processing multimedia programs that are not playable on a digital audio player, said programs being composed of composite signals including an audio program component and a video component comprising:
>
> an input port used to receive a composite signal;
>
> *an extractor* coupled to said input port and *adapted to selectively extract said audio component from said composite signal without extracting said video signal*[2];
>
> a processor that processes said audio component to generate a processed audio signal in a format that can be received and played by the digital audio player; and
>
> an output port for outputting said processed audio signal.

Claims 1, 6, 7, 11, 14, 15, 17, 18, 25-31, 33-36 and 38[3] are rejected under 35 U.S.C. § 102(e) as anticipated by Martin (U.S. Patent No. 7,174,512 B2).

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[1] Claims 2-5, 8-10, 12, 13 and 19-24 have been cancelled.
[2] We note that claim 1 does not earlier recite a "video signal". Rather, claim 1 includes a "video component" and a "composite signal".

Claims 16, 32 and 37 are rejected under 35 U.S.C. § 103(a) as unpatentable over Martin and Inoue (U.S. Patent No. 6,580,462 B2).

ISSUES

Did the Examiner err in finding that Martin describes: (1) an extractor adapted to extract an audio component from a composite signal without extracting the video signal; (2) a folder circuit adapted to fold a multichannel audio signal to generate a stereo audio signal; and (3) extracting a metadata component and storing it as part of an audio file?

ANALYSIS

We have reviewed the Examiner's rejection in light of Appellant's arguments (Appeal Brief[4] and Reply Brief). We disagree with Appellant's arguments and concur with the Examiner's determination that claims 1, 6, 11, 17, 18, 25, 26, 28-31, 33, 36 and 38 are anticipated and that claims 32 and 37 are obvious. However, we concur with Appellant's arguments that the Examiner erred in determining that claims 7, 14, 15, 27, 34 and 35 are anticipated and claim 16 is obvious. We provide the following additional findings of fact and analysis.

Claims 1, 11, 17, 18, 25, 28-31, 33, 36 and 38

Independent claims 1, 11, 17 and 28 stand rejected as anticipated by Martin. Appellant presents arguments addressing independent claims 1, 17 and 28 together as anticipated by Martin. App. Br. 10-14. In the Reply Brief, Appellant asserts that Martin does not anticipate claims 11 and 28 for

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[3] In the Amended Appeal Brief ("App. Br.") filed August 11, 2009, Appellant mistakenly lists claims 11, 14-16, 28, 33 and 34 as rejected under 35 U.S.C. § 102 (e) as anticipated by Inoue. App. Br. 10.

[4] Refers to the Amended Appeal Brief filed August 11, 2009.

the same reasons as claim 1. Reply Br. 4. Since the disputed limitations of claims 11 and 28 are nearly identical to those of independent claims 1 and 17, all of which are rejected as anticipated by Martin, we treat independent claims 1, 11, 17 and 28 together as a group, with claim 1 as the representative claim. Further, because Appellant does not present substantive arguments separately addressing the limitations of claims 18[5], 25, 29-31, 33, 36[6] and 38, ultimately dependent from claims 1, 11 and 17, these claims are grouped together with claim 1. 37 C.F.R. § 41.37 (c)(vii).

We begin our analysis with the construction of independent claim 1. "Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted). Appellant emphasizes that claim 1 requires the extractor to extract the audio component from a composite signal without extracting the video component of the composite signal. App. Br. 12-14; Reply Br. 2, 5. Appellant asserts that Martin does not describe the disputed limitations because Martin describes an apparatus in which both the video and audio components are extracted. App. Br. 12-14; Reply Br. 2, 5.

While Appellant advocates a claim construction in which the extractor extracts only the audio and not the video component, or an extractor which

[5] Appellant addresses claim 18 separately, but argues the limitations found in claim 27 instead of the limitations of claim 18. Reply Br. 3.
[6] Appellant groups claim 36 together with claims 7, 26 and 35. Reply Br. 3. Distinct from claims 7, 26 and 35, claim 36 does not recite a folder circuit or folding the multichannel audio signal into a stereo signal.

is precluded from separately extracting the video signal (App. Br. 13-14), we decline to adopt Appellant's claim construction. The language of claim 1 does not require the extractor to extract only the audio component, nor does it preclude the extractor from separately extracting the video signal or component. Rather, we broadly construe the "extractor . . . adapted to selectively extract said audio component from said composite signal without extracting said video signal" to mean that the audio component is selectively extracted from the composite signal by the extractor and that the extracted audio component does not include any extracted video signals or components.

The Examiner finds that Martin meets the disputed claim limitations based on Martin's description of a Set Top Box (STB) that: (1) receives a signal containing both audio and video signals; (2) filters or extracts the audio signals from the video signals; and (3) passes the filtered audio data to a dedicated audio decoder or processor. Ans. 4, 10-11 (citing col. 5, l. 32 to col. 6, l. 6; col. 7, l. 56 to col. 8, l. 1); *see also* Fig. 3A.

While Martin also describes that the STB Demultiplexer/Descrambler separately filters or extracts the video signal from the audio signal and passes the filtered video data to a dedicated video decoder or processor (col. 7, l. 56 to col. 8, l. 14; Fig. 3A), claim 1 does not require the extractor to extract only the audio component nor does it preclude a separate extraction of the video signal. Therefore, we are unpersuaded by Appellant's arguments that Martin does not describe the disputed claim limitations because both the audio and video signals are extracted by the Demultiplexer/Descrambler. App. Br. 12-14; Reply Br. 5.

Appellant's argument that Martin teaches away from the claimed invention (App. Br. 13) is misplaced because whether a reference teaches away is inapplicable to anticipation. *Celeritas Techs, Ltd. v. Rockwell Int'l. Corp.*, 150 F.3d 1354, 1361 (1998).

Last, we are unpersuaded by Appellant's argument that Martin does not describe a processor that takes the audio component extracted from the multimedia signal and converts it into a signal suitable for playing by a digital audio player. App. Br. 14. As pointed out by the Examiner, Martin describes that the filtered or extracted audio signals are processed separately by a dedicated audio decoder and passed to an audio output of a set top box (STB) (i.e., an audio player). Ans. 12-13 (citing col. 7, l. 51-col. 8, l. 1). Moreover, Martin describes that the decoded signals may also be provided to other devices which may include, for example, audio equipment for outputting music. Col. 5, l. 66 to col. 6, l. 6; Figs. 2-3.

For all these reasons, we sustain the rejection of claims 1, 11, 17, 18, 25, 28-31, 33, 36 and 38 as anticipated by Martin.

Claims 6 and 26

Appellant argues that Martin does not describe an audio processor that converts the audio component into a standard stereo signal, as required by claims 6 and 26. App. Br. 14; Reply Br. 3. Appellant's arguments are not commensurate in scope with the claim limitations. Instead, claim 6, dependent from claim 1, recites: "said audio component includes a multichannel audio signal and wherein said processed signal includes a stereo audio signal." Claim 26 recites nearly identical limitations as claim 6. Furthermore, the recitations of a "multichannel audio signal" and a "stereo signal" merely describe the quality or attributes of the audio signal. The

audio signal attributes or quality does not affect or describe the function of the processor, although it may provide insight regarding the intended use of the processor. Accordingly, a "multichannel audio signal" and a "stereo signal" constitute non-functional descriptive material which is not entitled to patentable weight. *See In re Ngai*, 367 F.3d 1336, 1338-39 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). *See also Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential). Moreover, as pointed out by the Examiner (Ans. 5), Martin provides for receiving the audio data from multi-channel parallel broadcast sources (col. 6, ll. 7-24). Martin further describes providing the processed audio data to audio equipment for outputting music (col. 5, l. 66 to col. 6, l. 6). The claimed stereo audio signal is well known by ordinary skilled artisans as an audio signal applied to audio equipment for outputting music.

For all these reasons, we sustain the rejection of claims 6 and 26 as anticipated by Martin.

Claims 7, 14-16, 34 and 35

Claim 7, dependent from claim 1 recites: "said processor includes a folder circuit adapted to fold said multichannel audio signal . . . ." Claims 14-16, 34 and 35 either depend from or recite limitations that are nearly identical to the disputed limitations of claim 7. The Examiner finds that Martin meets the limitations of claim 7 (Ans. 5) and directs attention to the following description in Martin:

> In a multichannel system, multiplexer 1040 handles audio and video data received from a number of parallel sources and interacts with transmitter 1080 to broadcast the information along a number of channels. In addition to audio and video data, messages, applications (software programs), CD-quality audio data or any other type of digital data may be introduced

> into some or all of these channels intermixed with the transmitted digital audio and video data. For a particular transport stream to be received by STB 1140, the relevant program identifier (PID) is determined, and then packets having a matching PID value are filtered. To identify which PID corresponds to which program, signal tables are transmitted with a description of each program carried within the MPEG-2 transport stream. Signal tables are sent separately from the packetized elementary stream (PES), and are not synchronized with the elementary streams (i.e., they are an independent control channel). The signal tables include . . . .

Col. 6, ll. 7-24. Appellant argues that the cited portions of Martin describe receiving signals encoded using various formats and does not describe folding signals. App. Br. 14; Reply Br. 3.

The Examiner further finds that Martin discloses processing multichannel audio signal (Ans. 18) and directs attention to the following description in Martin:

> For the portal of FIG. 5C, the composite video stream and all of the audio streams are carried in a single MPEG-2 program sharing a common clock reference as explained above. The audio streams are duplicated in both the full screen program and the portal interface program. This allows the portal to tune to the audio of programs carried on different transport streams as further explained above.

Col. 13, ll. 56-62.

We agree with Appellant that the cited portions of Martin do not describe a folder circuit or folding signals. Although Martin describes a multichannel system and duplication of audio streams, the Examiner does not direct us to where, nor meaningfully explain how, Martin describes a folder circuit adapted to fold a multichannel audio signal to generate the stereo signal.

For all these reasons, we do not sustain the rejection of claims 7, 14, 15, 34 and 35 as anticipated by Martin. Claim 16, ultimately dependent from claim 14, stands rejected as obvious over Martin and Inoue. As applied by the Examiner, Inoue does not remedy the deficiencies of Martin. Ans. 8. For these additional reasons, we do not sustain the rejection of claim 16 as obvious over Martin and Inoue.

Claim 27

Appellant argues that Martin does not describe the limitations of claim 27 which recites: "extracting from said multimedia program a metadata component and storing said metadata component as part of said audio file[7]." Reply Br. 3. The Examiner does not direct us to where, nor meaningfully explain how, Martin describes the limitations of claim 27. Accordingly, we do not sustain the rejection of claim 27 as anticipated by Martin.

Claims 32 and 37

Claim 32, ultimately dependent from claim 1, recites: "said processed signal is a compressed signal in one of an MPEG and an ATRAC standard." Claim 37, ultimately dependent from claim 17, has substantially identical limitations. Appellant does not substantively address the limitations of claims 32 and 37. App. Br. 18-19. Instead, Appellant argues that since Martin does not describe the limitations of independent claims 1 and 17, the combination of Martin and Inoue do not meet all of the limitations of the claims. App. Br. 18-19.

[7] We note that claim 27, and claim 17 from which it depends, do not earlier recite an "audio file". Rather claims 17 and 27 recite an "audio component" or "a processed audio signal in a format compatible with . . . ."

Since Appellant does not substantively address the limitations of claim 32 and 37 nor the combined teachings of Martin and Inoue, we sustain the rejection of claims 32 and 37 as obvious over Martin and Inoue for the same reasons we sustain the rejection of claims 1 and 17.

DECISION

We AFFIRM the rejection of claims 1, 6, 11, 17, 18, 25, 26, 28-31, 33, 36 and 38 under 35 U.S.C. § 102(e) as anticipated by Martin.

We REVERSE the rejection of claims 7, 14, 15, 27, 34 and 35 under 35 U.S.C. § 102(e) as anticipated by Martin.

We REVERSE the rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over Martin and Inoue.

We AFFIRM the rejection of claims 32 and 37 under 35 U.S.C. § 103(a) as unpatentable over Martin and Inoue.

AFFIRMED-IN-PART

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